

ESTTA Tracking number: **ESTTA227999**Filing date: **08/01/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Williams-Sonoma, Inc.		
Entity	Corporation	Citizenship	California
Address	3250 Van Ness Ave. SAN FRANCISCO, CA 94111 UNITED STATES		

Attorney information	Marie C. Seibel Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor SAN FRANCISCO, CA 94111 UNITED STATES mcseibel@townsend.com, amw@townsend.com Phone:415-576-0200
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Registration Subject to Cancellation

Registration No	3446212	Registration date	06/10/2008
Registrant	Birgers, Chris 10565 Beardon Drive Cupertino, CA 95014 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2006/04/20 First Use In Commerce: 2006/04/20
All goods and services in the class are cancelled, namely: RETAIL STORE SERVICES FEATURING KITCHENWARE, LINENS AND HOUSEHOLD GOODS

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Wrong Entity and Abandonment

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77405626	Application Date	02/25/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DESIGN, DECOR & MORE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 041. First use: First Use: 2006/08/00 First Use In Commerce: 2006/08/00 Entertainment in the nature of on-going segments of television programs in the field of home design and decoration

Attachments	77405626#TMSN.jpeg (1 page)(bytes) Petition for Cancellation.pdf (12 pages)(467848 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MCS/
Name	Marie C. Seibel
Date	08/01/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 3,446,212
Registered: June 10, 2008
For: DESIGN, DÉCOR, & MORE

Williams-Sonoma, Inc.,
PETITIONER,

v.

Chris Birgers,
REGISTRANT.

Cancellation No. _____

PETITION FOR CANCELLATION

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Madam:

Petitioner Williams-Sonoma, Inc., a corporation duly organized and existing under the laws of the State of California and having its headquarters at 3250 Van Ness Ave., San Francisco, California 94109, seeks relief from damage by the continued registration of the mark shown in U.S. Registration No. 3,446,212, and hereby petitions for cancellation of same.

As grounds for cancellation, Petitioner alleges:

1. Petitioner has adopted and continuously used the mark DESIGN, DECOR & MORE ("Petitioner's Mark") since at least as early as August 2006 (well before Registrant's May 11, 2007 filing date) for ongoing segments of television programs in the field of home design and decoration.

2. Petitioner owns U.S. Trademark Application No. 77/405,626 for DESIGN, DECOR & MORE in connection with the aforementioned services.

3. Petitioner provides retail store services featuring various household goods, such as linens, decorative items and furniture. Registrant Chris Birgers' ("Registrant") registration and website indicate Registrant is in the same line of business as Petitioner.

4. By virtue of Petitioner's extensive use and promotion of Petitioner's Mark, Petitioner has established valuable goodwill in the mark, and the public has come to associate Petitioner's Mark with Petitioner. As such, the public has come to know Petitioner's Mark as an indication of services that originate from Petitioner.

5. Registrant filed U.S. Trademark Application Serial No. 77/178,821 on May 11, 2007, based on his purported intent to use DESIGN, DECOR, & MORE ("Registrant's Mark") for "retail store services featuring kitchenware, linens and household goods" in International Class 35.

6. Registrant's application for DESIGN, DECOR, & MORE proceeded to registration on June 10, 2008. The resultant registration, U.S. Trademark Registration No. 3,446,212 (the "Registration"), is the subject of this proceeding.

7. On information and belief, Registrant, a former employee of Petitioner, intentionally selected Registrant's Mark to reference or create an association with Petitioner and/or Petitioner's Mark.

LIKELIHOOD OF CONFUSION

8. Registrant's services, as described in the Registration, are closely related to the services identified in Petitioner's application and with which Petitioner uses Petitioner's Mark.

9. For example, Petitioner's DESIGN, DÉCOR & MORE television segments address home design and decoration, featuring goods such as those Registrant claims to provide through the retail services identified in the Registration.

10. Registrant's Mark is nearly identical to Petitioner's Mark, and the sole difference between the two marks is the inclusion of a second comma in Registrant's Mark after the word "DÉCOR."

11. As a result of the similarity between Petitioner's Mark and Registrant's Mark and the highly related nature of the services associated with each party's respective mark, Registrant's mark is likely to cause confusion, mistake or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties' respective services.

FRAUD

12. In support of Registrant's application for DESIGN, DECOR, & MORE, Registrant's counsel submitted a Statement of Use and specimen (attached hereto as Exhibit A) to the Patent and Trademark Office on February 25, 2008.

13. On information and belief, as of February 25, 2008, Registrant had not used Registrant's Mark in U.S. interstate commerce in connection with the services identified in Registrant's application for DESIGN, DECOR, & MORE.

14. On information and belief, as of February 25, 2008, none of the links on Registrant's website—a printout of which was submitted as his specimen of use on that date—were operational.

15. On information and belief, the website shown in the specimen Registrant submitted to the Patent and Trademark Office on February 25, 2008 displayed no goods for customers to purchase, and no means for contacting Registrant to order any goods.

16. On information and belief, one or more material representations of fact were made by Registrant and/or Registrant's counsel at the time of filing and/or during the prosecution of the application leading to the Registration.

17. On information and belief, Registrant's counsel's February 25, 2008 representations to the Patent and Trademark Office on Registrant's behalf regarding purported use of the DESIGN, DECOR, & MORE mark in commerce were false.

18. On information and belief, Registrant knew or should have known that such misrepresentations of fact as referenced in Paragraphs 10 through 15 herein were false and/or misleading.

19. On information and belief, Registrant's counsel knew or should have known that such misrepresentations of fact as referenced in Paragraphs 10 through 15 herein were false and/or misleading.

20. On information and belief, Registrant committed fraud in attempting to procure a registration for Registrant's Mark, thus making the Registration void *ab initio*.

WRONG ENTITY

21. On information and belief, Registrant, an individual, filed the present application on behalf of Registrant's company, and the submitted specimen shows use of the mark by said company, not Registrant. As such, the Registration should be found void *ab initio* because this ownership defect cannot be corrected.

ABANDONMENT

22. On information and belief, Registrant abandoned use of the Registrant's Mark, without an intent to resume, on the services identified in the Registration.

23. On information and belief, the Registrant's Mark has never been in use in commerce, on or in connection with the services identified in the Registration.

24. Accordingly, the Registration should be cancelled due to abandonment, pursuant to Trademark Act Section 14, 15 U.S.C. §1064(3).

25. The continued registration of Registrant 's mark shown in the Registration will result in damage to Petitioner under the provisions of 15 U.S.C. § 1052(d) and 15 U.S.C. §1064(3) pursuant to the allegations stated above.

26. The Registration presumptively entitles Registrant to *prima facie* exclusive ownership and rights to Registrant's Mark. The Registration is likely to result in confusion among consumers as to the separate and distinct sources of Registrant's services and Petitioner's services and the relationship of Registrant to Petitioner, thereby damaging Petitioner's goodwill in Petitioner's Mark, resulting in irreparable harm to Petitioner's business and reputation, all to the detriment of Petitioner who has expended considerable sums and effort in promoting Petitioner's Mark.

Wherefore, Petitioner prays that this Petition for Cancellation be granted and that U.S. Trademark Registration No. 3,446,212 be canceled.

Please charge any necessary fee regarding this Opposition to the Deposit Account of Townsend and Townsend and Crew, LLP, 20-1430, and credit any overpayment to such deposit account. Please direct all notices, pleadings and process regarding this matter to:

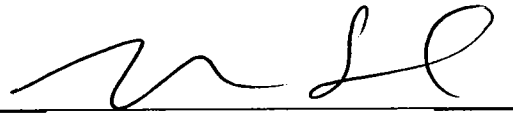
Anthony J. Malutta, Esq.
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San Francisco, CA 94111-3834
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mcseibel@townsend.com

Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

Dated: August 1, 2008

By



Anthony J. Malutta
Marie C. Seibel
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF CANCELLATION** has been served on counsel for applicant by mailing said copy on August 1, 2008, via First Class Mail, postage prepaid to:

Chris Birgers
10565 Beardon Drive
Cupertino, CA 95014

Molly B. Markley
Young Basile Hanlon Macfarlane
3001 W Big Beaver Rd Ste 624
Troy MI 48084

Signed by: 
Antonia M. Wong

61437585 v1

EXHIBIT A

Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77178821
LAW OFFICE ASSIGNED	LAW OFFICE 104
NOTICE OF ALLOWANCE	YES
EXTENSION OF USE	NO
REQUEST TO DIVIDE	NO
MARK SECTION	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	DESIGN DECOR & MORE
OWNER SECTION (current)	
NAME	Birgers, Chris
STREET	10565 Beardon Drive
CITY	Cupertino
STATE	California
ZIP/POSTAL CODE	95014
COUNTRY	United States
OWNER SECTION (proposed)	
NAME	Birgers, Chris
STREET	10565 Beardon Drive
CITY	Cupertino
STATE	California
ZIP/POSTAL CODE	95014
COUNTRY	United States
EMAIL	docketing@youngbasile.com
ATTORNEY SECTION (current)	
NAME	Molly B. Markley
FIRM NAME	YOUNG BASILE HANLON MACFARLANE & ET AL
STREET	3001 W BIG BEAVER RD STE 624
CITY	TROY
STATE	Michigan
POSTAL CODE	48084-3107
COUNTRY	United States
PHONE	248-649-3333
FAX	248-649-3338
EMAIL	docketing@youngbasile.com
ATTORNEY DOCKET NUMBER	CHB-100-SM

ATTORNEY SECTION(proposed)

NAME	Molly B. Markley
FIRM NAME	YOUNG BASILE HANLON MACFARLANE & ET AL
STREET	3001 W BIG BEAVER RD STE 624
CITY	TROY
STATE	Michigan
POSTAL CODE	48084-3107
COUNTRY	United States
PHONE	248-649-3333
FAX	248-649-3338
EMAIL	docketing@youngbasile.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY DOCKET NUMBER	CHB-100-SM
OTHER APPOINTED ATTORNEY	Kathleen G. Mellon (P26473) and Andrew R. Basile, Jr., Reg. No. 35438

GOODS AND/OR SERVICES SECTION

INTERNATIONAL CLASS	035
CURRENT IDENTIFICATION	RETAIL STORE SERVICES FEATURING KITCHENWARE, LINENS AND HOUSEHOLD GOODS
GOODS AND/OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	04/20/2006
FIRST USE IN COMMERCE DATE	04/20/2006
SPECIMEN FILE NAME(S)	\\TICRS2\EXPORT15\771\788\77178821\xml2\SOU0002.JP G
SPECIMEN DESCRIPTION	a scanned image of the website promoting the retail store services

PAYMENT SECTION

NUMBER OF CLASSES	1
SUBTOTAL AMOUNT	100
TOTAL AMOUNT	100

SIGNATURE SECTION

SIGNATURE	/Molly B. Markley/
SIGNATORY'S NAME	Molly B. Markley
SIGNATORY'S POSITION	Attorney and Authorized Agent for Applicant
DATE SIGNED	02/25/2008

FILING INFORMATION

SUBMIT DATE	Mon Feb 25 15:12:11 EST 2008
TEAS STAMP	USPTO/SOU-69.220.234.106- 20080225151211919074-7717 8821-400e955c6cd26dbe38a7 2f6b5341adb95e-DA-508-200 80225145254332764

(15 U.S.C. Section 1051(d))

To the Commissioner for Trademarks:

MARK: DESIGN DECOR & MORE

SERIAL NUMBER: 77178821

This Allegation of Use is being filed after a Notice of Allowance has issued.

The applicant, Birgers, Chris, having an address of 10565 Beardon Drive, Cupertino, California United States 95014, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class 035:

Current identification: RETAIL STORE SERVICES FEATURING KITCHENWARE, LINENS AND HOUSEHOLD GOODS

The applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 04/20/2006, and first used in commerce at least as early as 04/20/2006, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) a scanned image of the website promoting the retail store services.

Specimen File1

The applicant hereby appoints Molly B. Markley and Kathleen G. Mellon (P26473) and Andrew R. Basile, Jr., Reg. No. 35438 of YOUNG BASILE HANLON MACFARLANE & ET AL, 3001 W BIG BEAVER RD STE 624, TROY, Michigan United States 48084-3107 to submit this Trademark/Service Mark Statement of Use on behalf of the applicant. The attorney docket/reference number is CHB-100-SM.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Molly B. Markley/ Date Signed: 02/25/2008

Signatory's Name: Molly B. Markley

Signatory's Position: Attorney and Authorized Agent for Applicant

Mailing Address:

YOUNG BASILE HANLON MACFARLANE & ET AL

3001 W BIG BEAVER RD STE 624

TROY, Michigan 48084-3107

Mailing Address:

YOUNG BASILE HANLON MACFARLANE & ET AL

3001 W BIG BEAVER RD STE 624

TROY, Michigan 48084-3107

RAM Sale Number: 508

RAM Accounting Date: 02/26/2008

Serial Number: 77178821

Internet Transmission Date: Mon Feb 25 15:12:11 EST 2008

TEAS Stamp: USPTO/SOU-69.220.234.106-200802251512119

19074-77178821-400e955c6cd26dbe38a72f6b5

341adb95e-DA-508-20080225145254332764

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DESIGN, DECOR, & MORE TM

SAN FRANCISCO



SAN DIEGO



SCOTTSDALE



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